

**REMARKS**

**I. Status of the Claims**

Claims 1-71, 73, 74, 81-92, 94, and 95 are currently pending. Claims 86-92 have been withdrawn from consideration as drawn to a non-elected species. Claims 73 and 74 have been canceled without prejudice or disclaimer. Claims 1, 50, 81, 82, 83, and 84 have been amended. Support for the amended claims 1, 81, 82, 83, and 84 can be found throughout the application as filed, particularly at page 2, lines 5-13 and page 28, lines 17-19. Claim 50 was amended to correct a typographical error. Accordingly, no issue of new matter is raised by these amendments.

Applicants respectfully request entry of these amendments, and respectfully submit that the amendments place the application in condition for allowance, as discussed in more detail below. Applicants also submit that the present amendment would place the application in better form for appeal, should the Examiner continue to dispute the patentability of the pending claims.

Applicants acknowledge and thank the Examiner for withdrawing (1) the rejection of claims 1-16, 44-51, 60, 65-71, 82-85, 94, and 95 under 35 U.S.C. § 103(a) over U.S. Patent No. 5,885,498 to Glenn et al. ("Glenn") in view of EP 0874017 to Dalle et al. ("Dalle") and (2) the rejection of claims 52-59 and 61-64 under 35 U.S.C. § 103(a) over Glenn in view of Dalle and further in view of U.S. Patent No. 6,690,920 to Dubief et al.

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### III. Rejections Under 35 U.S.C. § 103(a)

#### A. Dalle in view of Groh

The Examiner has rejected claims 1-16, 44-47, 56, 73, 74, 81-85, 94, and 95 under 35 U.S.C. § 103(a) as unpatentable over *Dalle* in view of U.S. Patent No. 5,863,943 to Groh ("Groh") for the reasons set forth on pages 3-4 of the final Office Action. Applicants respectfully disagree with this rejection.

According to the Examiner, *Dalle*, the primary reference, teaches cosmetic compositions in the form of emulsions comprising the claimed at least one silicone and surfactants. *Office Action*, page 3. The Examiner notes that *Dalle* does not, however, teach the claimed at least one conditioner. *Id.* Accordingly, the Examiner finds this missing disclosure in *Groh*.

According to the Examiner, *Groh* discloses skin conditioning oil-in-water emulsions comprising moisturizing or emollient elements such as polydecanes, polyisobutene, hydrogenated polyisobutenes, and silicones. *Id.* The Examiner also alleges that *Groh* teaches the presently claimed ionic surfactants. *Id.*, page 4. Based on these teachings, the Examiner concludes that "it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have looked to the prior arts such as *Groh* because of an expectation of successfully producing a skin conditioning aqueous emulsion composition." *Id.* The Examiner also adds that "[t]he skilled artisan would have been motivated to add the traditional emollient oils . . . because of the expectation of successfully producing a skin care composition . . . ." *Id.*

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Applicants submit, however, that the Examiner's alleged evidence of a motivation to combine the teachings of the two references lacks the requisite specificity to justify a §103(a) rejection. See *In re Dembiczkak*, 175 F.3d 994, 999 (Fed. Cir. 1999) (requiring "clear and particular" evidence of a motivation to combine references). Specifically, in making the rejection, the Examiner has not demonstrated that the references, when considered as a whole, suggest the desirability of making the proposed combination.

More specifically, neither *Dalle* nor *Groh* suggest the desirability of adding *Groh*'s traditional emollient oils such as polydecane to *Dalle*'s compositions. *Groh* is specifically directed to skin conditioning emulsions comprising high concentrations of alpha hydroxy acids stabilized using polyethylene glycol and a cationic surfactant. See *Abstract*. *Groh* mentions that its inventive compositions may also include additional ingredients in the oil phase, such as polydecane, polyisobutene, silicones etc. See col. 2-col. 4. However, nothing from *Groh*'s disclosure would have led a person of ordinary skill in the art to select, out of context, *Groh*'s traditional emollient oils, to add to *Dalle*'s compositions.

*Dalle* also provides no support for the alleged modification. *Dalle* only teaches a method of making silicone in water emulsions. Nothing in this disclosure even remotely suggests the use of its silicone/water emulsions with *Groh*'s synthetic oils. Although *Dalle* does disclose that its emulsions can also include surfactants and other optional ingredients such as perfumes and thickeners, it notably does not even implicitly teach the presently claimed synthetic oils.

Indeed, the Examiner's line of reasoning is so broad it would render obvious the modification of any cosmetic composition by adding any ingredient disclosed in *Groh*.

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The Examiner relies heavily on the fact that the references teach similar applications (personal care compositions) and that emollient oils are known in the art to support the rejection of the present invention. Under this standard, *any* component that is also useful in, for example, a skin lotion, would be obvious to combine with *any other* component that is useful in shampoo, even without incentive to combine them. However, the law prescribes no such standard. Indeed, the Federal Circuit has consistently held that without proper motivation, a rejection based on *prima facie* obviousness is improper even if the combination of references taught every element of the claimed invention. See M.P.E.P. § 2143.01 (citing *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998)).

Applicants further submit that even if the individual components of the presently claimed invention are found separately in *Dalle* and *Groh*, the separate disclosures do not defeat the patentability of the composition as a whole. The Federal Circuit has been clear on this point, and has held that “[m]ost if not all inventions arise from a combination of old elements.... However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention.” *In re Kotzab*, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) (internal citations omitted). Accordingly, based on this premise, the Examiner’s rejection is improper and should be withdrawn for this reason alone.

Moreover, even if *Dalle* was combined with *Groh*, the resulting combination still would not yield the presently claimed invention. *Groh* is narrowly directed to skin conditioning emulsions, and would not have motivated one skilled in the art to isolate cosmetic ingredients used in a skin composition for use in a hair composition. Nowhere

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does *Groh* suggest that a modification to a hair composition based on a skin composition would result in any improved properties in any hair composition. Indeed, one object of *Groh* was to provide a "skin conditioning treatment, an O/W emulsion, which is stable, is a suitable carrier for one or more [alpha hydroxy acids, is a suitable carrier for topically active agents such as sunscreens, and the like." Col. 1, lines 51-55. Given *Groh*'s narrow focus, it leads away from the use of its ingredients in any composition but a skin composition. Accordingly, even if *Groh* were combined with *Dalle*, the resultant combination would have been a modified skin composition, and not a hair composition, as in the presently claimed invention. Accordingly, the Examiner's rejection is improper for this additional reason.

#### B. *Dalle* in view of *Dubief*

The Examiner has rejected claims 1-16, 44-71, 74, 81-84, 94, and 95 under 35 U.S.C. § 103(a) as unpatentable over *Dalle* in view of U.S. Patent No. 5,804,207 to *Dubief* et al. ("*Dubief*") for the reasons disclosed on pages 4-5 of the final Office Action. Applicants respectfully traverse this rejection.

The Examiner again notes that *Dalle* fails to teach the presently claimed oils and surfactants. *Office Action*, page 4. Accordingly, the Examiner relies on the teachings of *Dubief* which allegedly discloses cosmetic emulsions comprising the claimed surfactants and oils. *Id.* The Examiner concludes that "[t]he skilled artisan would have been motivated to add the well-known surfactants in the *Dubief* reference because of an expectation of successfully producing an emulsion shampoo composition with good washing and cosmetic properties and good texture." *Id.* at 5. The Examiner also alleges that "it would have been obvious to one of ordinary skill in the art at the time the

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invention was made to have looked to the prior arts such as *Dubief* because of an expectation of successfully producing an emulsion shampoo composition." *Id.* Applicants submit, however, that no motivation would have existed to lead one skilled in the art to make the proposed modification.

As with the rejection discussed above, having read *Dubief*'s disclosure, a person of ordinary skill in the art would hardly have been motivated to select, out of context, the presently claimed oils or surfactants. *Dubief* relates to a shampoo composition which requires the presence of "at least one anionic surfactant; at least one nonionic or amphoteric co-surfactant; at least one thickening polyacrylamide and at least one electrolyte." Col. 2, lines 25-30. One of ordinary skill in the art would not have been motivated to select, from the list of optional ingredients, synthetic oils because *Dubief* does not suggest that this ingredient would provide beneficial properties such as softness, disentangling, or styling. Rather, the *Dubief* inventors attribute these properties to its inventive combination.

Moreover, the presently amended claims recite that the composition be provided in various forms, such as, for example, a rinse-out hair conditioner, a leave-in hair conditioner, etc. See, e.g., Claim 1. *Dubief*, however, is specifically directed to shampoo compositions. Col. 2, lines 11-15. Thus, nothing in *Dubief* would have motivated one skilled in the art to provide a composition in a form other than a shampoo.

Even if *Dubief* is read in conjunction with *Dalle*, the references still would not render the present invention obvious. As discussed above, *Dalle* neither explicitly nor implicitly suggests that its silicone emulsions could be used with synthetic oils, let alone

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*Dubief's* synthetic oils. Accordingly, Applicants respectfully request that the Examiner withdraw this rejection as well.

### C. *Iwao* in view of *Dalle*

The Examiner has rejected claims 1-17, 25, 27, 44-46, 56, 70, 71, 73, 74, 81-84, 94, and 95 as unpatentable under 35 U.S.C. § 103(a) over U.S. Patent No. 4,183,917 to *Iwao et al.* ("*Iwao*") in view of *Dalle* for the reasons disclosed on pages 5-6, and 7-8 of the final Office Action. Applicants disagree with this rejection as well.

The Examiner alleges that *Iwao* teaches hair conditioner compositions comprising synthetic oils, such as alpha-olefin polymers, quaternary ammonium salts, and nonionic surfactants. *Office Action*, p. 5. The Examiner admits that *Iwao* fails to teach the presently claimed polysiloxane, therefore she again cites *Dalle* to make up for this deficiency. *Id.* Without sufficiently rebutting the arguments of record, the Examiner, relying on *In re Kerkhoven*, contends that it is "prima facie obvious to combine two compounds each of which is taught by the prior art to be useful for the same purpose, in order to form a composition which is to be used for the same purpose." *Office Action*, page 8. The Examiner's reliance on *Kerkhoven*, however, is improper in this case.

In *Kerkhoven*, the appealed claims related to a detergent which was a simple combination of two prior art detergents, i.e., the allegedly novel invention was solely a straightforward mixture of complete detergent compositions. Thus, the Court of Customs and Patent Appeals held that the "appealed claims . . . require no more than the mixing together of two conventional detergents," and thus the claims were *prima facie* obvious. 626 F.2d at 850.

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The presently claimed invention, however, is not a simple combination of the compositions taught by *Iwao* and *Dalle*. Rather, in order to arrive at the presently claimed invention, the Examiner has picked and chosen ingredients from each reference without citing any support for *why* one skilled in the art would have selected those specific ingredients. At best, the Examiner has merely demonstrated that it would have been obvious to try various combinations of known cosmetic ingredients in an attempt to obtain the claimed invention, which is not the standard required by law. Rather, the prior art must also provide sufficient impetus to lead one of ordinary skill to make the combination. The Examiner, however, has provided no such justification. Therefore, Applicants respectfully request that this rejection be withdrawn as well.

#### **D. *Iwao* and *Dalle* in view of *Restle***

Finally, the Examiner has rejected claims 18-24, 26, 28-43, 47-51, 60, and 65-69 under 35 U.S.C. § 103(a) as unpatentable over *Iwao* and *Dalle* and further in view of U.S. Patent No. 6,039,936 to *Restle* et al. ("*Restle*") for the reasons disclosed on pages 6-7 and 8 of the final Office Action. Applicants respectfully traverse this rejection as well.

The Examiner alleges that *Restle* generally teaches cosmetic oil-in-water emulsions comprising nonionic amphiphilic lipids, cationic amphiphilic lipids, synthetic essential oils, and cationic surfactants. *Office Action*, p. 6. The Examiner further notes that *Restle* teaches that the advantages of its compositions include enhanced penetration of active ingredients on hair and glossy appearance without greasy feel and softness. *Id.*, page 7. Without addressing the arguments of record, the Examiner

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concludes that it would have been obvious to substitute the cationic surfactants disclosed in *Iwao* with *Restle*'s cationic amphiphilic lipids based on the expectation of a similar glossy appearance and softness to the hair. *Id.* Applicants respectfully disagree.

Applicants submit that even if *Restle* does teach cationic amphiphilic lipids as discussed above, *Restle* does not cure the deficient disclosure of the *Iwao* and *Dalle* references. Because there would have been no motivation to combine *Iwao* and *Dalle*, it necessarily follows that no motivation could have existed in the further modification of this proposed combination with *Restle*. Thus, for this reason alone the Examiner should withdraw the improper § 103(a) rejection.

Moreover, the references, whether taken individually or combined, fail to objectively teach or suggest the presently claimed combination. It seems that the Examiner has again merely combined various ingredients from each reference without looking at each reference as a whole as required. *Restle* is drawn to an oil-in-water emulsion having oil globules with a mean size of 150 nm and an amphiphilic lipid phase containing at least one non-ionic amphiphilic lipid which is liquid at an ambient temperature of less than 45°C, and at least one cationic amphiphilic lipid. See e.g., Abstract. Importantly, *Restle* never suggests, implicitly or even explicitly, selecting one limitation from its invention, i.e., the cationic amphiphilic lipids, and incorporating it into a composition comprising the presently claimed "at least one silicone." Nor can this suggestion be found in either *Iwao* or *Dalle*. Rather, this suggestion derives solely from the present invention. Therefore, Applicants respectfully request that the Examiner withdraw this improper rejection.

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#### IV. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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